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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,806	04/13/2004	Charles Huston	5863-00301	5187
35617	7590	11/16/2005	EXAMINER	
DAFFER MCDANEIL LLP			PHAN, DAO LINDA	
P.O. BOX 684908			ART UNIT	
AUSTIN, TX 78768			PAPER NUMBER	

3662

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,806

Applicant(s)

HUSTON ET AL

Examiner

Dao L. Phan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. In the Board of Appeals decision of October 10, 2000 in prior application no. 08/334,733, the Board stated that claim 1 (now claims 21, and 37) does not recite the "freight yard" for Bickley reference only. However, the Board affirmed the rejection of claim 1 as anticipated by Mansell et al, the rejection of claim 1 as being unpatentable over Rudnicki in view of Mansell et al, the rejection of claim 1 as being unpatentable over Burns in view of Mansell et al, and the rejection of claim 1 as being unpatentable over Welles II et al in view of Mansell et al. (see Decision p. 17)

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 21-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-22 of U.S. Patent No. 6,266,008. Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the features of claims 21-37 are broadly read over the features of claims 3-22 of U.S. Patent No. 6,266,008.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless.—

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 21-28, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Mansell et al (Pat. No. 5,223,844).

Mansell et al teach the claimed system for determining freight container locations (train 102E and fleet vehicles 102B-102D in fig. 1, col 7, lines 8-13) including: remote GPS receivers attachable to freight containers (314 in fig. 2A), base station 150, means 110 for communicating data, sensors (372, 374, 376 and 378, in fig. 2A), differential GPS (col 7, lines 42-45), enabling means 215 (fig. 2A), timer (202 and 215 in fig. 2A and 2B), motion detector 372.

The system of Mansell et al will locate the freight containers (located on the freight container vehicle, train 102E and fleet vehicle 102B-102D in fig. 1, col 7, lines 8-13 in a "freight yard".

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 21-28, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welles II et al (Pat. No. 5,491, 486) in view of Mansell et al.

Welles, II et al teach the claimed system for determining freight container locations (10D and 12D in fig. 1) including remote GPS receivers attachable to freight containers (50 in fig. 2), base station 18, means 16 for communicating data, sensors (56 and 68 in fig. 2, col 4, lines 43+, col 5, lines 37+, col 6, lines 55+), enabling means (timer) 60 to provide intermittent operation (col 4, lines 60-64). The freight containers of Welles, II et al will be located in a "freight yard" as claimed.

To increase the accuracy of the GPS location system of Welles II et al, obviously the GPS systems of Wells II et al can use the well known differential correction method taught by Mansell et al (col 7, lines 42-45).

8. Claims 21-28, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudnicki (Pat. No. 4,896,580) in view of Mansell et al.

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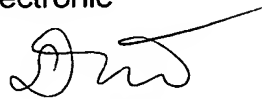
Rudnicki teaches the claimed system for determining freight container locations (202) including remote GPS receivers attachable to freight containers (202), base station (260 in fig. 2), means 274, 280, 282, 288, 289 and 294 for communicating data, and sensors connected to 214. The freight containers will be located in a "freight yard" as claimed.

To increase the accuracy of the GPS location system of Rudnicki, obviously the GPS systems of Rudnicki can use the well known differential correction method taught by Mansell et al (col 7, lines 42-45).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dao L. Phan whose telephone number is (571)272-6976. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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